REMARKS

Applicant has amended claims 1, 4, 6, and 20 merely to promote clarity. **The amendments should be entered as it raises no new issues that will require further consideration or search and also does not touch the merits of the application within the meaning of 37 C.F.R. § 1.116(b)**. In addition, Applicant has cancelled claims 2, 3, 7, and 8 to more particularly claim his invention. Claim 5 was previously cancelled.

Claims 1, 4, 6, and 9-20 are pending. Applicant respectfully requests that the Examiner reconsider this application, as amended, in view of the following remarks.

Rejection under 35 U.S.C. § 101

The Examiner rejects claims 2, 3, 7, and 8 for double-patenting, relying on claims 1, 2, 5, and 6 of copending application 10/567,616. Applicant has cancelled claims 2, 3, 7, and 8. Thus, this rejection is rendered moot.

Rejection under 35 U.S.C. § 102/103

The Examiner rejects claims 2, 3, 7, and 8 for anticipation or alternatively for obviousness, relying on Chang *et al.*, US Patent 5,955,532. This rejection is also rendered moot by cancellation of the rejected claims.

Rejection under 35 U.S.C. § 112, second paragraph

The Examiner rejects claim 20 for indefiniteness on the ground that "[i]t is not clear if the percentage [recited therein] is [calculated] based on [the solids of] the entire multilayer coating or just the layer comprising the microgel." See the Office Action, page 2, lines 4-5.

Applicant disagrees. Original claim 20 recites that "the percentage of the microgel, relative to the solids of the coat obtainable therefrom, is between 20 and 85%." An ordinary person, not even a person of ordinary skill, would understand that the term "therefrom" corresponds to "from the microgel." Thus, the term "solids" recited in this claim, without a doubt, refers to those of the coat containing the microgel. In short,

contrary to the Examiner's assertion, it is clear that the percentage recited in claim 20 is calculated based on the solids of the coat containing the microgel.

In addition, the Examiner's rejection is believed to be improper on a separate and independent ground.

The specification describes that, "[f]or example, a waterborne basecoat [] with just the addition of 20% the emulgator-free microgel dispersion under the invention-relative to the solids contents of the coating composition shows a viscosity of a most of 110 mPa*s at a shear rate of 1,000 s^{-1}." See page 12, lines 26-32. In view of this statement in the specification, one skilled in the art would understand that the coating composition, corresponding to the coat recited in claim 20, contains the microgel.

In this connection, Applicant would like to point out that the law is well established that one should resort to the specification when determining whether claim language is definite. More specifically, "[t]he test for definiteness under 35 U.S.C. 112, second paragraph, is whether 'those skilled in the art would understand what is claimed when the claim is read in light of the specification.'" See MPEP § 2173.02, quoting *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986). As discussed above, in light of the specification, the coat recited in claim 20 refers to that containing the microgel. It follows that one skilled in the art would understand that the percentage recited in claim 20 is calculated based on the solids of the coat containing the microgel. Thus, contrary to the Examiner's belief, claim 20 is definite.

In any event, to eliminate any ambiguity, Applicant has amended claim 20 to replace the recitation "the solids of the coat obtainable therefore" with "the solids of the coat containing the microgel." The indefiniteness rejection should therefore be removed.

Allowable Subject Matter

The Examiner acknowledges that claims 1, 4, 6, and 9-19 are allowable. See the Office Action, page 3, lines 3-4. Applicant submits that claim 20 is also allowable as the rejection of this claim has been overcome for the reasons set forth above.

In short, all of the pending claims, i.e., claims 1, 4, 6, and 9-20, are in condition for allowance. It is respectfully requested that the Examiner promptly issue a Notice of Allowance.

CONCLUSION

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

The Petition for Extension of Time fee in the amount of $65 is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply any other charges or credits to Deposit Account No. 50-4189, referencing Attorney Docket No. 68002-004US1.

Respectfully submitted,

Date: 3-4-09

Y. Rocky Tsao, Ph.D., J.D.
Attorney for Applicant
Reg. No. 34,053

Customer No. 69713
Occhiuti Rohlicek & Tsao LLP
10 Fawcett Street
Cambridge, MA 02138
Telephone: (617) 500-2527
Facsimile: (617) 500-2499